

### **REMARKS**

The following remarks are in response to the Examiner's Office Action mailed on August 26, 2003 and Applicants' telephone interview with Examiner Arun Chakrabarti, Ph.D., on Jan. 21, 2004. Claims 1, 15-18 and 30-37 have been amended. Claims 1-42 are pending.

#### **I. Rejection under 35 U.S.C. § 103(a) over O'Hare et al. in view of Kain et al.**

The Examiner rejected claims 1-10, 13-21, 22-39 and 41-42 under 35 U.S.C. §103(a) over O'Hare et al. (PCT International Publication No. WO 00/08182) (February 17, 2000) in view of Kain et al. (U.S. Pat. No. 6,306,600 B1) (October 23, 2001).

Applicants express appreciation to the Examiner for conducting a telephone interview with Applicants on January 21, 2004. Pursuant to the interview, Applicants amend independent claims 1, 17, 18, 32 and 35 to specify that the methods utilize a library of cells, each of which expresses a **different** fusion protein encoded by a cDNA **library** by varying sequence encoding the fusion protein within the cDNA library. In contrast, O'Hare et al. teaches construction of a recombinant virus encoding a **single** herpesviral structural protein, VP22, fused with GFP. See "Abstract", page 1, lines 16-24 and page 10, lines 10-25. This recombinant virus was used to inoculate cells. Thus, O'Hare et al. fails to teach or suggest constructing a library of cells expressing a **library of different fusion proteins**.

The secondary reference, Kain et al., fails to supplement the claim elements missing from O'Hare et al. in order to establish a prima facie case of obviousness under 35 U.S.C. §103(a). As acknowledged in the Office Action and agreed to by the Examiner during the interview, Kain et al. merely teaches a method of inhibiting further expression of a single fusion protein, e.g., EGFP-MODC, in cells. Nowhere in this reference could be found teaching or suggestion of a method for selecting cells expressing short-lived proteins by utilizing cells expressing a library of different fusion proteins.

In view of the distinct differences between the claimed invention and the teaching of the cited references, a prima facie case of obviousness under 35 U.S.C. §103(a) has not been established. Withdrawal of the rejection is therefore respectfully requested.

**II. Rejection under 35 U.S.C. § 103(a) over O'Hare et al. in view of Kain et al. and further in view of Bachmair et al.**

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) over O'Hare et al. in view of Kain et al. and further in view of Bachmair et al. (Science, (October 10, 1996), Vol. 234, pages 179-186).

As discussed in detail above, O'Hare et al. and Kain et al. fail to teach or suggest a method for selecting cells expressing short-lived proteins by utilizing cells expressing a library of different fusion proteins. As acknowledged by the Examiner, Bachmair et al. merely teaches a method of analyzing a fusion protein by pulse-chase analysis and by autoradiography.

Thus, the cited references, each alone or in combination, fail to teach or suggest the claimed invention. A prima facie case of obviousness under 35 U.S.C. §103(a) has not been established. Withdrawal of the rejection is therefore respectfully requested.

**III. Rejection under 35 U.S.C. § 103(a) over O'Hare et al. in view of Kain et al. and further in view of Dantuma et al.**

Claim 40 is rejected under 35 U.S.C. 103(a) over O'Hare et al. in view of Kain et al. and further in view of Dantuma et al., (Nature Biotechnology, (May 18, 2000), vol. 18, pages 538-543).

As discussed in detail above, O'Hare et al. and Kain et al. fail to teach or suggest a method for selecting cells expressing short-lived proteins by utilizing cells expressing a library of different fusion proteins. As acknowledged by the Examiner, Bachmair et al. merely teaches a method of screening cells using flow cytometer.

Thus, the cited references, each alone or in combination, fail to teach or suggest the claimed invention. A prima facie case of obviousness under 35 U.S.C. §103(a) has not been established. Withdrawal of the rejection is therefore respectfully requested.

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Reply to Office Action of August 26, 2003

**CONCLUSION**

In light of the amendments and arguments set forth above, Applicants earnestly believe that they are entitled to a letters patent, and respectfully solicit the Examiner to expedite the prosecution of this patent application to issuance. Should the Examiner have any question, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,

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